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Paper No. 21

RFC

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

House of Blues Brands Corp.

v.

Sylvia Woods, Inc.

Opposition No. 117,309  
to application Serial No. 77/342,413  
filed on August 15, 1997.

Kirt S. O'Neill of Akin, Gump, Strauss, Hauer & Feld, L.L.P.  
for House of Blues Brand Corp.

Van DeWard Woods, Chief Executive Officer of Sylvia Woods,  
Inc., for Sylvia Woods, Inc., pro se.

Before Cissel, Quinn and Hairston, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 15, 1997, applicant, a corporation organized  
and existing under the laws of the state of New York, filed  
the above-identified application to register the mark HOUSE  
OF SOUL on the Principal Register for what were subsequently  
identified by amendment as "entertainment, namely, live  
music by musical performing groups, small bands, and  
singers; comedy performances, poetry readings, lectures and  
seminars, related to matters of politics, culture, local

interest, history, literary and musical," in Class 41, and "restaurant services," in Class 42. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in interstate commerce in connection with these services. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use the word "HOUSE" apart from the mark as shown.

On February 22, 2000, a Notice of Opposition was timely filed by House of Blues Brands Corp., a Delaware corporation with offices in Hollywood, California. As grounds for opposition, opposer alleged that, in conjunction with its parent company, HOB Entertainment, Inc., opposer is a renowned provider of restaurant and nightclub services featuring live music which is performed on the premises; that these services are rendered under the mark HOUSE OF BLUES; that these services are rendered under this mark in major United States cities including Cambridge, Los Angeles, New Orleans, Chicago, Orlando, Myrtle Beach and Las Vegas; that opposer has rendered its restaurant/nightclub services under the mark since at least as early as November, 1992; that opposer has registered<sup>1</sup> the mark HOUSE OF BLUES for bar and restaurant services; that opposer operates a music recording studio under the mark HOUSE OF BLUES STUDIOS and

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<sup>1</sup> Reg. No. 1,772,628, issued on May 18, 1993.

has registered<sup>2</sup> that mark for those services; that as early as January, 1995, opposer sponsored and produced nationally broadcast television programs featuring a wide variety of musical entertainment under the mark LIVE FROM THE HOUSE OF BLUES; that opposer registered<sup>3</sup> that mark for "entertainment services, namely an on-going television variety series"; that in conjunction with its parent company, opposer uses its HOUSE OF BLUES mark in connection with providing live and pre-recorded musical entertainment over the Internet by the House of Blues website at <http://www.hob.com> and at two related websites; that opposer produces and sells collections of music on cassettes, compact discs and videotapes; that opposer has registered<sup>4</sup> the mark HOUSE OF BLUES in connection with "prerecorded audio and videotapes, cassettes, cartridges, compact discs, phonograph records and other sound recordings featuring music"; that in conjunction with its parent company and affiliates, opposer operates the International HOUSE OF BLUES Foundation, a non-profit educational and cultural center, and has registered<sup>5</sup> INTERNATIONAL HOUSE OF BLUES FOUNDATION and design for "non-profit educational services, namely providing courses, seminars, lectures and presentations concerning culture and

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<sup>2</sup> Reg. No. 2,047,856 issued on March 25, 1997.

<sup>3</sup> Reg. No. 1,953,059, issued on January 30, 1996; canceled under Section 8.

<sup>4</sup> Reg. No. 1,933,441, issued on November 7, 1995; affidavit under Section 8 accepted; affidavit under Section 15 acknowledged.

history"; that as a result of its efforts, opposer has become widely known as a leading provider of musical entertainment, both live and pre-recorded, much of which originates from opposer's elaborate restaurant/live music venues and Internet websites; that opposer's HOUSE OF BLUES family of marks has become highly distinctive and famous by virtue of opposer's lengthy, extensive and nationwide use and promotion of its marks in connection with its renowned HOUSE OF BLUES restaurant/live music venues, its production and distribution of live and pre-recorded music and its provision of charitable educational services concerning culture, history and music; that opposer's HOUSE OF BLUES mark became famous for opposer's restaurant and nightclub services, prerecorded music, live musical entertainment and charitable educational services prior to any adoption or use of the mark HOUSES OF SOUL by applicant; that the mark applicant seeks to register so resembles opposer's famous mark that if applicant used its mark in connection with the services recited in the opposed application, it would be likely to cause confusion, or to cause mistake, or to deceive as to the source or origin of said services; and that, if used in connection with the services set forth in the application, the mark applicant seeks to register is likely to dilute the distinctive quality of opposer's HOUSE

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<sup>5</sup> Reg. No. 2,187,390 issued on September 8, 1998.

OF BLUES mark, which is famous in connection with opposer's restaurant and nightclub services, pre-recorded music, live musical entertainment, and charitable education services.

Following a Notice of Default that was subsequently set aside, applicant filed its answer to the Notice of Opposition, denying the essential allegations therein.

A trial was conducted in accordance with the Trademark Rules of Practice. Only opposer, however, took testimony or introduced evidence in this proceeding. Initially, applicant was represented by counsel, but on October 17, 2001, applicant's attorneys withdrew from representing applicant in this proceeding, citing applicant's failure to pay as a reason. Applicant's Chief Executive Officer, Mr. Woods, acted on behalf of his employer from that point forward.

Opposer fully briefed its case, Mr. Woods responded on behalf of applicant, and opposer filed a brief in reply to his response. Neither party requested an oral hearing before the Board.

Opposer's record is extensive. It includes copies of opposer's pleaded registrations, all made of record by a proper Notice of Reliance; applicant's responses to opposer's interrogatories 4, 20 and 30, made of record by opposer's Notice of Reliance; three dictionary definitions and explanations of the meaning and historical development

of the words and music genres "blues," "rhythm and blues" and "soul" from The New Grove Dictionary of Music and Musicians, made of record by opposer's Notice of Reliance; and the testimonial deposition, with exhibits, of Daniel L. Fishkin, opposer's senior vice president and general counsel.

Opposer's testimony and evidence establish that the first HOUSE OF BLUES restaurant was opened in a converted house in Harvard Square in Cambridge, Massachusetts in 1982. By the close of its testimony period, opposer was operating eight full-service music-themed restaurant establishments under the mark in the United States. In addition to a dining hall, each has a separate music hall for live music and talent performances and a retail shop selling collateral merchandise such as clothing, glassware, sunglasses, recordings and food products, all sold under opposer's HOUSE OF BLUES mark.

Since 1982, HOUSE OF BLUES restaurant and music venues have opened in New Orleans, Louisiana; West Hollywood, California; Chicago, Illinois; Myrtle Beach, South Carolina; Orlando, Florida; Las Vegas, Nevada and Anaheim, California. Opposer's restaurant/nightclub operations in Florida, California, Illinois, Louisiana and Nevada are located within major tourist attractions in order to increase the size of the audiences. These HOUSE OF BLUES venues are not

just restaurants; rather they are elaborate entertainment facilities. The California HOUSE OF BLUES facility, for example, was constructed in 1994 at a cost of more than thirty million dollars. Each HOUSE OF BLUES venue is furnished and decorated to project "a Southern Delta-style blues juke joint theme." In keeping with this theme, opposer's restaurants specialize in southern-style "Delta" cuisine. Each venue features a wide variety of popular music including, but not limited to, blues, urban, hip-hop, rhythm and blues, rock, alternative rock, swing, retro, techno, gospel and electronic music. Each HOUSE OF BLUES venue features a high tech sound stage and state-of-the-art lighting so that the nationally known bands and music stars who frequently perform at the HOUSE OF BLUES have a facility which meets their standards. Some HOUSE OF BLUES venues also feature secondary stages, which provide opportunities for local bands and newly discovered performers to showcase their talents.

In addition to the core restaurant/nightclub business which opposer conducts under its HOUSE OF BLUES mark, opposer also promotes and produces live concerts at large outdoor arenas and amphitheaters, produces recorded music and produces pay-per-view online concert performances. Opposer also produces a nationally syndicated weekly radio program called "The HOUSE OF BLUES Radio Hour," operates

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HOUSE OF BLUES Hotels, and conducts a number of charitable activities, all under the HOUSE OF BLUES mark.

Opposer uses its HOUSE OF BLUES mark to promote approximately twenty major concerts each year and to promote live music concerts at venues ranging from small nightclubs to twenty-thousand-seat amphitheaters. Opposer also promotes concert tours by different musical groups under the HOUSE OF BLUES mark.

Opposer's HOUSE OF BLUES music studio recording business produces and distributes compact discs under the HOUSE OF BLUES mark. Opposer's website features live pay-per-view online concert performances, advance ticket purchasing, schedules of upcoming events at HOUSE OF BLUES venues and archived recordings of concerts. Opposer's HOUSE OF BLUES Radio Hour program began in 1995, and now reaches approximately 125 United States markets. In the mid-1990s, opposer aired a television show called "Live From the HOUSE OF BLUES," which reached thousands of cable customers on the Turner Network. Opposer's hotel operations under its HOUSE OF BLUES mark include a 367-room HOUSE OF BLUES hotel in Chicago adjacent to the HOUSE OF BLUES restaurant there and the 100-room "HOUSE OF BLUES" hotel floor in the Las Vegas Mandalay Bay resort. The rooms on the HOUSE OF BLUES hotel floor are decorated in a style similar to that used in applicant's HOUSE OF BLUES restaurant/music venues.



The House of Blues Foundation is a nonprofit charity which promotes education, diversity and racial harmony through music, art and culture. The foundation teaches children the history of the blues and other music genres.

Opposer has extensively promoted its core and its non-core businesses under its HOUSE OF BLUES mark in many ways, including the Internet, radio, television, newspapers, magazines, music festival programs, posters, flyers, handouts and direct mailings. Opposer promotes its HOUSE OF BLUES services and products by sponsoring televised sporting events, high-visibility celebrity events, and music and folk art festivals. Since 1997, opposer has spent over forty-two million dollars advertising and promoting its HOUSE OF BLUES goods and services.

The record establishes beyond question that opposer's HOUSE OF BLUES mark is famous. This fact is clearly reflected in published articles made of record in connection with Mr. Fishman's testimony. In addition to the tremendous expenditures for promotional activity, the record reflects that opposer's goods and services sold under its HOUSE OF BLUES mark have resulted in gross revenues of almost eight hundred million dollars from 1997 through May of 2001. In 2000, for example, four million people visited opposer's HOUSE OF BLUES restaurant/entertainment establishments and another six and a half million people purchased tickets to

opposer's HOUSE OF BLUES concerts. A customer survey which opposer had conducted in 1999 showed that forty percent of respondents in Chicago and New Orleans named opposer's clubs as their favorite place to go to hear live music being performed. No competitor received more than a ten percent response. Well known performers and other famous people, including former President Clinton, former Vice President Gore, Dan Aykroyd, Bob Dylan, Stevie Wonder, Paul Simon and B.B. King, have appeared at opposer's HOUSE OF BLUES venues, and many of these events have been widely publicized.

As noted above, applicant did not take any testimony or introduce any evidence in this proceeding. The information we have about applicant's operations and its attempt to register the mark HOUSE OF SOUL comes from the application itself and from applicant's responses to opposer's interrogatories, made of record by opposer.<sup>6</sup>

According to applicant's response to Interrogatory No. 20, Mr. Woods visited opposer's HOUSE OF BLUES operation in Cambridge Massachusetts in 1997. In July of that year, applicant claims to have started using the HOUSE OF SOUL mark at a banquet facility adjacent to applicant's

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<sup>6</sup> Neither the rambling narrative submitted as applicant's brief on the case nor the exhibits attached to it are evidence in this opposition proceeding. If applicant had wanted to introduce evidence or take testimony, which would of course have been necessary in order to establish a factual basis for any of its allegations or arguments, it could have done so during its designated testimony period. Applicant did not do so.

restaurant in Harlem, New York. For the next two years, applicant claims to have offered open-microphone nights for musical performances each week under that mark. From that time through November, 2000, applicant sponsored approximately ten musical performances and poetry readings under the mark it seeks to register. Although the application is based on the assertion that applicant intends to use the mark in connection with its services, applicant's response to Interrogatory No. 4 indicated that applicant claims to have actually used its mark in connection with musical performances and restaurant services since 1997.

In view of opposer's obvious priority of use and ownership of registrations for its mark, the issues before the Board in this opposition proceeding are whether opposer's HOUSE OF BLUES mark is famous; whether applicant's mark, HOUSE OF SOUL, as used in connection with the services specified in the application, so resembles opposer's mark that it is likely to cause confusion, mistake or to deceive; and whether applicant's mark should be refused registration because when it is used in connection with the services set forth in the application, it is likely to cause dilution within the meaning of the Lanham Act. For the reasons set forth below, we hold that opposer's mark is famous in connection with opposer's restaurant and musical entertainment services, that applicant's mark so resembles

it that when applicant uses its mark in connection with the services recited in the application, confusion is likely; and that when applicant uses its mark in connection with the recited services, it is likely to cause the dilution of opposer's famous mark.

As noted above, the record clearly establishes that opposer's HOUSE OF BLUES mark is famous in connection with opposer's services. The amount and scope of advertising, promotion, and business done under opposer's mark is huge by almost any standard. As opposer points out, it exceeds what was deemed sufficient to establish that HARD ROCK CAFE, the mark of one of opposer's primary competitors, is a famous mark in this field of commerce. See: Hard Rock Cafe Int'l (USA) Inc. v. Elsea, 56 USPQ2d 1504, 1509-1510 (TTAB 2000).

Fame is one of the thirteen factors identified by the predecessor to our primary reviewing court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). When a mark is famous, it is accorded a broader scope of protection than would be the case if it were not famous. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). Competitors must steer clear of the "long shadow" cast by famous marks. *Kenner Parker Toys Inc. v. Rose Art*

Industries, Inc., 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

"When marks would appear on virtually identical goods or services, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698, 1700 (Fed. Cir. 1982). In the instant case, confusion is likely because applicant's mark creates a commercial impression which is similar to the one engendered by opposer's mark, and the services set forth in the application are identical to those opposer renders under its famous mark.

Turning first to a comparison of the services, we note that we must compare the respective services of the parties as they are recited in the application and the registration, respectively, without limitations or restrictions not reflected therein. *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340 (TTAB 1983). Applicant recites its services in terms of musical entertainment and restaurant services. Opposer has used and registered its mark for identical services.

Applicant's mark closely resembles opposer's famous mark. Although there are arguably subtle distinctions between the musical genres named in the marks, purchasers of opposer's goods and services and applicant's services, ordinary consumers buying amusement without a particularly

high level of care or sophistication, are likely to confuse the two marks. The record includes no evidence of anyone other than opposer using HOUSE OF with other words in connection with goods or services related to those in connection with which opposer uses its HOUSE OF BLUES mark. Mr. Fishkin, whose business it is to know about such an occurrence if it ever happened, was not aware of any third party using such a mark. Significantly, applicant's recitation of services is not limited to "soul music," but rather encompasses the blues within the term "live music." Moreover, the record shows that opposer presents a wide variety of types of music under its mark.

Opposer asserts that because Mr. Woods visited opposer's Cambridge HOUSE OF BLUES venue in 1997 and began using and applied to register its HOUSE OF SOUL mark that same year, the Board should infer that applicant intended to trade off the goodwill opposer has built up in its famous mark. Based on the record before us, however, we cannot reach that conclusion. To begin with, it is unclear whether Mr. Davis' visits to the Cambridge HOUSE OF BLUES preceded applicant's adoption of its mark. Moreover, even if it had, we would have difficulty inferring from that fact that applicant's selection of its mark at that time was with the intent of evoking opposer's mark. In any event, in view of the fame of opposer's mark, the similarity of applicant's

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mark to it, and the identity of the services rendered under the two marks, we do not need to make such a finding in order to hold that confusion is likely within the meaning of Section 2(d) the Lanham Act.

We therefore need not reach the pleaded claim of dilution under Section 43(c) of the Act.

In summary, the record supports opposer's priority and its pleaded claims of fame and likelihood of confusion. Applicant provided absolutely no evidence or testimony to the contrary.

DECISION: The opposition is sustained and registration to applicant is refused under Section 2(d) of the Lanham Act.